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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,660	08/03/2001	Klaus Heckel	22750/488	8200
26646	7590	06/09/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			SIMONE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,660

Applicant(s)

HECKEL ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8,9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8,9 and 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Withdrawn Rejections***

2. The 35 U.S.C. 103 rejection of claims 1, 2, 5, 6, 8, 9 and 11-21 of record in Paper mailed 4/5/04, Pages 2-4, Paragraph #3 has been withdrawn due to the Applicants response filed 5/21/04.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 5, 6, 8, 9 and 11-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shultz et al. (US 5,670,237) in view of Heckel et al. (5,154,868).

Shultz et al. discloses a floor covering having a relief-type patterned surface (see col. 5, lines 62-66), wherein the surface is provided with irregularly distributed indentations, which have an elongated shape, which partially contact or intersect each other wherein at least one of the indentations is configured so as to run to a point (see Figure 5 shown below). However, Shultz et al. fails to disclose the floor covering comprising an elastomer material. Heckel et al.

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teaches that it is old and well-known in the analogous art to have a floor covering made of an elastomer material for the purpose of producing a floor covering having a relief-type patterned surface. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the floor covering in Shultz et al. to comprise an elastomer material as suggested by Heckel et al. in order to produce a floor covering having a relief-type patterned surface.

Furthermore, regarding claim 1, Shultz et al. fails to disclose the indentations having a depth of 0.02 mm to 0.2 mm, at a width of 0.2 mm to 2.5 mm and a length of 5 mm to 50 mm and regarding claim 2, Shultz et al. fails to disclose the indentations having a depth of 0.025 mm to 0.05 mm, at a width of 0.4 mm to 1.3 mm and a length of 6 mm to 40 mm. Shultz et al., however, teaches the indentations having a depth ranging from "very shallow (e.g., less than 0.010") to deep (e.g., 0.750")" (see col. 6, lines 11-15) and a varying width such as a narrow/small embossing width and a medium embossing width (see col. 7, line 12 and 18-20). Therefore, the optimum ranges for the depth, width and length of the indentations would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results as shown by Shultz et al. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the indentations in Shultz et al. to have a depth of 0.02 mm to 0.2 mm, at a width of 0.2 mm to 2.5 mm and a length of 5 mm to 50 mm, and a depth of 0.025 mm to 0.05 mm, at a width of 0.4 mm to 1.3 mm and a length of 6 mm to 40 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges

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involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05* (II).

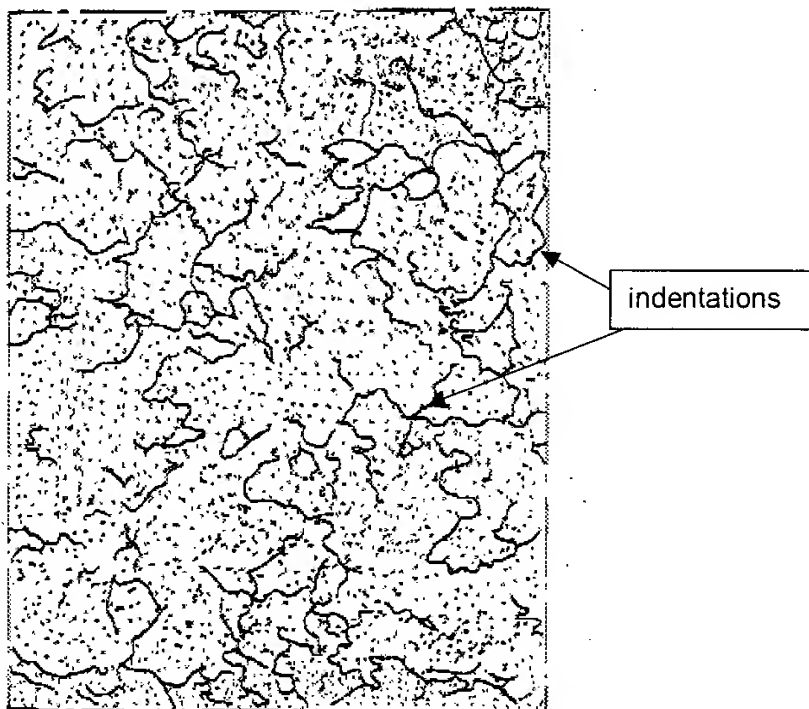
Regarding **claims 5 and 6**, note each indentation intersects at least two other indentations (see Figure 5 shown below). Regarding **claims 8 and 9**, note the indentations have shapes that differ one from the other (see Figure 5 shown below). Regarding **claim 11**, note the surface percentage of the indentations is 5% to 50% of the total surface of the floor covering (see Figure 5 shown below). Regarding **claim 12**, note the surface percentage of the indentations is 20% to 40% of the total surface of the floor covering (see Figure 5 shown below). Regarding **claim 13**, note the indentations have the same depth over their entire length (see col. 6, lines 15-17). Regarding **claim 14**, note the remaining surface of the floor covering is essentially planar (see Figs. 3a-3d). Regarding **claim 15**, note the width of the individual indentations varies (see Fig. 3b). Regarding **claim 16**, note the length of the individual indentations varies (see Fig. 5 shown below). Regarding **claim 18**, note the floor covering is assembled from individual, repeating surface units (see col. 6, lines 26-30). Regarding **claim 19**, note the floor covering is made up of a single-layer material (see col. 5, lines 55-61). Regarding **claims 20 and 21**, note the floor covering has a thickness in the range of 2 mm to 5 mm and in the range of 2.5 mm to 4 mm (see col. 11, lines 31-32).

Regarding **claim 17**, Shultz et al., also, fails to disclose the shape of the indentations wherein at least one of the lateral border edges of the indentations at at least one location widens, to the outside, or narrows, to the inside. Normally, it is to be expected that a change in shape of the indentations would be an unpatentable modification. Under some circumstances, however, changes such as shape may impart patentability to a product if the particular shape claimed

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produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. MPEP 2144.04 IV (B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to change the shape of the indentations in Schultz et al. wherein at least one of the lateral border edges of the indentations at at least one location widens, to the outside, or narrows, to the inside. One skilled in the art would have been motivated to do so in order to form a floor covering, since it has been held that the change in form or shape of the indentations would be an unpatentable modification in absence of showing unexpected results.

**FIG. 5**

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***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 2, 5, 6, 8, 9 and 11-21 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501.


The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine Simone  
Examiner  
Art Unit 1772  
June 4, 2004



**WILLIAM P. WATKINS III  
PRIMARY EXAMINER**